

REMARKS

-- Claims 1-24 are pending and stand rejected. Claims 9, 11 and 16 are amended by way of this amendment to clarify the subject matter of the invention. All pending claims, as amended, are believed to be allowable over the references cited by the Examiner as discussed below. Accordingly, a Notice of Allowance for the present application is respectfully requested.

Objection to Specification

The disclosure was objected to by the Examiner because of formalities. The paragraph in the specification starting on page 16, line 4 has been amended to address the objections raised by the Examiner. Accordingly, it is believed that the disclosure no longer contains the informalities objected to by the Examiner.

Objections to Claims 9, 11 and 16

Claims 9, 11 and 16 were objected to by the Examiner. Claims 9, 11 and 16 are amended address the objections raised by the Examiner. Accordingly, it is believed that these claims no longer contains the informalities as objected to by the Examiner.

Rejections Under 35 U.S.C. §103(a)

Claims 1-5, 7-10, 15 and 16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Bossemeyer, Jr. et al. in view of Gardell et al.

The Examiner cited Bossemeyer as disclosing a telephone network system providing analog voice telephony to a client premise and having a connection between the client premise and the central office carrying analog frequencies. The Examiner also cites Gardell as disclosing a derived voice over data termination device located outside of the client premise, the device converts between base band signals and derived voice over data signals.

The Examiner concludes that it would have been obvious to incorporate a derived voice over data termination device of Gardell into the system of Bossemeyer by collocating the derived voice over data termination device in the CO and connecting it to the connection to the client premise. The motivation would be to provide clients with a voice over data calling option for cost savings purposes.

Applicants respectfully disagree. Simply because the cited references disclose the various components of the recited system of independent claim 1 does not mean that the combined references disclose or even suggest the configuration of those components as recited in claim 1.

A It is the provision of a derived voice over data termination device outside of the client premise that provides analog voice telephony and thus the use of a conventional analog telephone in the client premise while using derived voice over data technology beyond the termination device.

preamble

B In Gardell, the gateway 32 communicates on the one hand with the client premise via a digital (packet switched) connection and on the other hand with the PSTN via an analog (circuit switched) connection. In particular, the gateway "provides signal conversion capabilities between a switched circuit network, for example the PSTN 22, and a PBN [(packet based network)], to support communication therebetween." (Col. 4, lines 8-11). The Examiner suggests that it would have been obvious to connect Gardell's gateway collocated in the central office to an analog connection to the client premise.

However, such a modification would simply not make technical sense nor would it result in the intended purpose suggested by the Examiner. Specifically, connecting the gateway 32 to the client premise via the circuit switched (analog) connection would result in the gateway 32 converting the circuit switched (analog) signals to packet switched (digital) signals. But signal conversion of the circuit switched connection with the client premise is neither necessary nor desirable as the gateway is connected to the PSTN (circuit switched). In other words, one would connect the client premise directly to the PSTN as both are circuit switched nodes.

C Applicants further submit that there is a lack of motivation to combine the references. The Examiner justifies the combination of the references by stating that the motivation to combine is the desire to provide clients with a voice over data calling option for cost savings purposes. However, "there must be some logical reason apparent from the positive, concrete evidence of the record which justifies the combination" of the references. In re Stemniski, 170 U.S.P.Q. 343 (CCPA 1971). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination or modification. In re Mills, 915 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). It must be the prior art that provides the motivation. In this case, none of the references provided any motivation. Rather, the Examiner cites the desirability of the invention as the motivation.

motivation is well known!

Such reasoning would render all references combinable as the desirable result of any invention would itself serve as the motivation to combine references.

Dependent claim 4 further recites a DSL access multiplexer (DSLAM) coupled between the derived voice over data termination device and a ATM switch, frame relay switch or router. The Examiner contends that Bossemeyer teaches a DSLAM 576 coupled between a derived voice over data termination device and an ATM switch (FIG. 19). However, Applicants submit that while Bossemeyer discloses a DSLAM and an ATM switch, Bossemeyer fails to disclose or even suggest a derived voice over data termination device. In addition, there is no motivation to modify the Gardell's system with Bossemeyer's DSLAM and ATM switch.

In view of the foregoing, withdrawal of the rejection of independent claim 1, as well as claims 2-5, 7-10, 15 and 16 dependent from claim 1, under 35 U.S.C. §103(a) is respectfully requested.

Independent claim 17 and claim 20 (dependent from claim 17) stand rejected under 35 U.S.C. §103(a) as being unpatentable over Gardell et al. in view of Bossemeyer, Jr. et al.

However, similar arguments as those discussed above also apply to claim 17.

In addition, claim 17 recites a derived voice over data termination device in a wire center and a derived voice over data switch coupled to the termination device and a public switched telephone network (PSTN).

As noted by the Examiner, Gardell does not teach a derived voice over data switch coupled to the PSTN. The Examiner notes that Bossemeyer teaches a PSTN connected to a wire center. The Examiner concludes that it would have been obvious to incorporate a PSTN into the network of Gardell for termination of the traditional voice call in the PSTN.

However, Gardell does disclose a PSTN (see FIG. 2) and yet Gardell makes no mention of connecting the router 34 to the PSTN 22 simply because such a connection would not result in a workable network. The PSTN 22 receives circuit-switched signals while the router 34 is routing packet-switched signals. In other words, reconnecting and/or reconfiguring the various components would result in a non-functional network and thus is neither suggested by the references nor does it read upon claim 17.

In view of the foregoing, withdrawal of the rejection of claim 17 as well as claim 20, dependent from claim 17, under 35 U.S.C. §103(a) is respectfully requested.

Independent claim 21 and claim 22 (dependent from claim 21) stand rejected under 35 U.S.C. §103(a) as being unpatentable over Gardell et al. in view of Dunn et al.

→ However, similar arguments as those discussed above also apply to claim 21.

In addition, claim 21 recites providing a base-band analog connection between the client telephone and the derived voice over data termination device. The Examiner contends that Gardell discloses such a connection between a telephone 26 and the gateway 32 (FIG. 2). However, Applicants note that the connection between the telephone 26 and the gateway 32 is via the PSTN and thus is not entirely a base-band analog connection. While the signals may be base-band analog on the terminating ends of the PSTN, the connection through the PSTN is not. In contrast, claim 21 recites that the connection between the telephone and the termination device is a base-band analog connection. Thus, Gardell does not disclose such a connection.

Claim 21 also recites transmitting base-band analog voice signals between the telephone and the termination device. Again, contrary to the Examiner's assertions, Gardell does not disclose such a transmission as the PSTN employ digital signaling over fiber optics.

Lastly, claim 21 recites transmitting derived voice over data signals between the termination device and a voice gateway connection to a PSTN. The Examiner relies on the secondary reference of Dunn to conclude that it would have been obvious to incorporate transmitting derived voice over data signals and a voice gateway into Gardell to enable the client to place voice calls over data network. However, the cited references lack any motivation to combine the teachings. Regardless, even if the references were combined, the resulting system would not read on claim 21 as the references fail to disclose several elements of claim 21, as discussed above.

As Gardell and Dunn, even when combined, fail to teach each and every element, withdrawal of the rejection of claim 21 as well as dependent claim 22 under 35 U.S.C. §103(a) is respectfully requested.

Claims 6, 11-14, 18, 19, 23 and 24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over various combinations of Bossemeyer et al., Gardell et al., Sisk et al., Jones et

al. and/or Dunn et al. However, as independent claims 1, 17 or 21 are believed to be allowable, dependent claims 2-16, 18-20 and 22-24 are also allowable at least for the same or similar reasons as those set forth above.

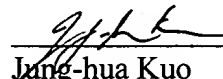
In view of the foregoing, withdrawal of the rejection of claims ** under 35 U.S.C. §103(a) is respectfully requested.

CONCLUSION

Applicant believe that all pending claims are allowable and respectfully request a Notice of Allowance for this application from the Examiner. Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at the telephone number set out below.

In the unlikely event that the transmittal letter accompanying this document is separated from this document and the Patent Office determines that an Extension of Time under 37 CFR 1.136 and/or any other relief is required, Applicant hereby petitions for any required relief including Extensions of Time and/or any other relief and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 50-1217 (Order No. COVDP001).

Respectfully submitted,



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